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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,035	09/22/2003	Dominic P. Behan	AREN-005CON (5.US10.CON)	2177
65643 7590 05/13/2010 Arena Pharmaceuticals, Inc. Bozicevic, Field & Francis LLP 1900 University Avenue, Suite 200 East Palo Alto, CA 94303				
EXAMINER				
LI, RUIXIANG				
ART UNIT		PAPER NUMBER		
1646				
MAIL DATE		DELIVERY MODE		
05/13/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,035

Applicant(s)

BEHAN ET AL.

Examiner

RUIXIANG LI

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-10 and 20-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-3, 8-10 and 20-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Election/Restrictions

1. In response to a communication mailed on 03/09/2010, Applicants argue that the restriction requirement mailed on 06/29/2006 only requires an election of a specific orphan GPCR if Applicants elects one of Groups I-III. Applicants argue that because Applicants elected Group V, an election of a specific orphan GPCR was not required. To clarify the restriction requirement with respect to election of a specific orphan GPCR, the Examiner sets forth the following restriction requirement.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, 8, 10, 20, 21, 23-25 (all in part), and 22, drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor GPR3 (SEQ ID NO: 46), class 435, subclasses 5.
 - II. Claims 1-3, 8, 10, 20, 21, and 23-25 (all in part), drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor GPR4 (SEQ ID NO: 60), class 435, subclasses 5.
 - III. Claims 1-3, 8, 10, 20, 21, 23-25 (all in part), and 9, drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor GPR6 (SEQ ID NO: 47), class 435, subclasses 5.
 - IV. Claims 1-3, 8, 10, 20, 21, and 23-25 (all in part), drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor GPR12 (SEQ ID NO: 48), class 435, subclasses 5.

- V. Claims 1-3, 8, 10, 20, 21, and 23-25 (all in part), drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor GPR21 (SEQ ID NO: 50), class 435, subclasses 5.
- VI. Claims 1-3, 8, 10, 20, 21, and 23-25 (all in part), drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor OGR1 (SEQ ID NO: 27), class 435, subclasses 5.
- VII. Claims 1-3, 8, 10, 20, 21, and 23-25 (all in part), drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor GHSR (SEQ ID NO: 45), class 435, subclasses 5.
- VIII. Claims 1-3, 8, 10, 20, 21, and 23-25 (all in part), drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor RE2 (SEQ ID NO: 23), class 435, subclasses 5.
- IX. Claims 1-3, 8, 10, 20, 21, and 23-25 (all in part), drawn to a method for identifying a candidate compound as an agonist or inverse agonist of orphan receptor ALO22171 (SEQ ID NO: 49), class 435, subclasses 5.
3. The inventions are distinct, each from the other for the following reasons. Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). In the instant case, the different inventions are drawn to completely different methods, each using an entirely different orphan receptor. These are not interchangeable and require non-cohesive searches and considerations.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the

election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (I).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on (571) 272-0835. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at the toll-free phone number 866-217-9197.

/Ruixiang Li/
Primary Examiner, Art Unit 1646

Ruixiang Li, Ph.D.
May 11, 2010